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Date: 26 Feb 2004

To: Pam Rader	From: Navin Natnithithadha
Application/Control Number: 09/470,116	Art Unit: 3736
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Decision to Grant Petition 11/05/03 (5 Pages)

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OFFICE OF PETITIONS

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In re Application of:

Claycomb, et al.

Filed: 25 January, 1995

Application No. 09/470,116

Docket No.: 11016.02

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ON PETITION

This is a decision on the renewed petition filed herein on 22 October, 2003, under 37 C.F.R. §1.137(b) (as to unintentional delay) to revive the above-identified application.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 8 November, 2001, and due (absent extension of time) on or before Friday, 8 February, 2002;
- the application was deemed abandoned after midnight 8 February, 2002;
- in the original petition, filed 29 July, 2003, Petitioner Paul J. Prendergast (Reg. No. 25,364) and former associate Robert J. Scheffel (Reg. No. 43,090) detail that: following Mr. Scheffel's 24 January, 2002, telephone conference with the Examiner regarding Petitioner's amendment filed on 24 August, 2001, and the non-final Office action of 8

November, 2001, the "Interview Summary" (transmitted via FAX on 25 January, 2002, and then mailed on 27 August, 2002) indicated that the Examiner would have to perform a further search; and Petitioner and Mr. Scheffel interpreted that to mean that they had to make no further response to the 8 November, 2001, non-final Office action; Mr. Scheffel also indicated that he left the employ of Petitioner's office in July 2002 to commence a judicial clerkship;

- the Interview Summary indicated that:
 - “Agreement with respect to the claims * * * g)x was not reached” (emphasis supplied); and the Examiner stated: “Discussed the differences and similarities between the claimed invention and the prior art reference. A search will be needed based on the discussion[,]” however, there is no indication that the Examiner withdrew or otherwise modified the Office action, and so relieved Petitioner of the timely response requirement under statute;
- Notice of Abandonment was mailed on 12 February, 2003;
- no Status Inquiry was filed regarding this matter between the date of abandonment (8 February, 2002) and the mailing of the Notice of Abandonment (12 February, 2003);
- Petitioner failed to file with the original petition a written reply to the 8 November, 2001, non-final Office action;¹
- the original petition was dismissed on 22 August, 2003, for failure to satisfy the “showing” and “reply” requirements of the regulations;
- the renewed petition was filed on 22 October, 2003, with a reply in the form of an amendment.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

¹ On Wednesday, 13 August, 2003, a call was placed by the Office of Petitions to Petitioner regarding this failure to file a reply, and when Petitioner did not answer his line a message was left with his office. As of this writing (Thursday, 14 August, 2003, Petitioner has not responded to that call..

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵ And the Petitioner must be diligent in attending to the matter.⁶ Failure to show diligence does not constitute the care required under Pratt.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷)

It long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.⁸ The Office has

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁸ See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.⁹ Such delays are inconsistent with a showing of diligence in the prosecution of one's application,¹⁰ and such a course of action would preclude revival of an application under 37 C.F.R. §1.137.¹¹)

Allegations as to the Petition
Alleging Unintentional Delay

Petitioner has filed the petition (with fee), a reply in the form of an amendment and made the statement of unintentional delay.

CONCLUSION

The record (including the petition filed on 22 October, 2003) does not necessitate a finding that the delay between midnight 8 February, 2002, and 22 October, 2003, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's (Paul J. Prendergast (Reg. No. 46,068) duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.¹²

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is being forwarded to Technology Center 3700 for further processing in due course.

⁹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

¹⁰ The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

¹¹ That an applicant may have been preoccupied with other matters that took precedence over the revival of an abandoned application is not viewed as an adequate justification for delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Rather, the revival of an application that was not intentionally abandoned is the applicant's "most important business." See Ex parte Pratt, 1887 Dec. Comm'r Pats. 31, 32-33 (1887). Specifically, an applicant seeking revival of an abandoned application is expected to file a petition under 37 C.F.R. §1.137 within two to three months of discovering its abandonment. See In re Kokaji, 1 USPQ2d 2005, 2007 (Comm'r Pats. 1986); see also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53161, 1203 Off. Gaz. Pat. Office at 88-89 (response to comment 65).

¹² See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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